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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,808	12/27/2001	Masaya Nagata	1248-0572P	1384
2292	7590	04/27/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			FERNANDES, CHERYL M	
			ART UNIT	PAPER NUMBER
			2163	

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/026,808

Applicant(s)

NAGATA, MASAYA

Examiner

Cheryl M Fernandes

Art Unit

2163

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-29,31,33,35,37,39,41 and 43.

Claim(s) withdrawn from consideration: _____

claims 29,31,33,35,37,39,41 and 43 have been amended to overcome a 112 2nd paragraph rejection, by deleting the relative term "proximate" from the claim language

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments filed March 25, 2005 have been fully considered but they are not persuasive.

Referring to independent claims 1, 15, 17, 19, 29, 35, 37, and 41, Applicant argues that Tibbs does not disclose requiring a user to download label information related to a label affixed to an arbitrary commodity. Examiner respectfully disagrees. Examiner respectfully asserts that Tibbs teaches a user downloading a return shipping label from an ASP application that is affixed to a package to be returned (para. 41-42).

Referring to claims 8, 12, 14, 16, 18, 24, 31, 33, 39, and 43, in response to applicant's argument that Tibbs et al is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Tibbs is reasonably pertinent to the problem with which the Applicant was concerned because it is directed toward allowing a user to download label information related to a commodity (Tibbs, para. 41 and 42).

Referring to claims 8, 12, 14, 16, 18, 24, 31, 33, 39, and 43, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, although Cusack does not specifically show the access destination information including a uniform resource locator directly provided on material associated with a commodity, Tibbs teaches including a URL address of a webpage that contains the shipping label of a commodity to be shipped (Tibbs, Abstract; para. 34, 37, 38, and 41), therefore, it would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Cusack with access destination information including a Uniform Resource Locator directly provided on material associated with a commodity, as taught by Tibbs for the purpose of having an improved method and system for handling product returns with the ability to generate and send a return-shipping label to a customer using the Internet (Tibbs, para. 2 and 6).

Referring to claims 8, 12, 14, 16, 18, 24, 31, 33, 39, and 43, Applicant argues that the combination of Cusack/Tibbs fails to teach access destination including a uniform resource locator directly provided on material associated with a commodity. Examiner respectfully disagrees. Examiner respectfully asserts that the combination of Cusack/Tibbs teaches including a URL address of a webpage that contains the shipping label of a commodity to be shipped (Tibbs, Abstract; para. 34, 37, 38, and 41).



UYEN LE
PRIMARY EXAMINER